

REMARKS

Claims 1-19 are currently pending in the subject application and are presently under consideration. Claims 1 and 19 have been amended to correct certain informalities as shown at pages 2-5 of the Reply. It is noted that these amendments do not necessitate a new search or any undue effort by the Examiner as they do not present new claimed subject matter. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-19 Under 35 U.S.C. §101

Claims 1-19 stand rejected under 35 U.S.C. §101 because the disclosed invention is inoperative and therefore lacks utility. This rejection should be withdrawn for at least the following reasons. Claims 1 and 19 have been amended herein to recite *an output manager that facilitates at least one of selectively pulling and pushing a subset of the one or more input XML items prior to transforming the one or more input XML items*. It is contended in the Office Action that the subject claims are inoperative because it was unclear how pushing or pulling a subset of transformed XML items could be performed prior to transforming input XML items. The subject claims have been amended to recite that a subset of the one or more input XML items are selectively pushed or pulled prior to the transformation of *the one or more input XML items*. Thus the transformer transforms a subset of XML items, which are pushed or pulled before the transformer completes the transformation of all the XML items input to the system.

In view of the foregoing, it is believed that the subject invention is operative and useful, thus it is respectfully requested that this rejection be withdrawn.

II. Rejection of Claims 1-19 Under 35 U.S.C. §101

Claims 1-19 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reasons. Claims 1-19 produce a useful, concrete, and tangible result.

Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d

1352, 1358. (Fed. Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

In the subject Office Action, it is contended, without additional rationale for rejecting the subject claims, that the claims do not have a practical application because the claims do not disclose a physical transformation. Applicants' representative contends that a conclusory assertion without more does not meet the sufficiency of the Examiner's burden with respect to this rejection, and thus it is submitted, the Examiner has failed to set forth *prima facie* grounds to substantiate the rejection under 35 U.S.C. §101 with respect to this claim.

Further, according to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. The subject claim clearly meets the aforementioned legal standard. Independent claims 1 and 19 recite a *transformer that transforms one or more input XML items in a first format to one or more transformed XML items in one or more second formats and an output manager that facilitates at least one of selectively pulling and pushing a subset of the one or more input XML items prior to transforming all the one or more input XML items.* Thus, claims 1 and 19 recite independent acts (transforming one or more input XML items in a first format to one or more second formats and selectively pushing and pulling a subset of one or more input XML items) that facilitate the processing of XML items from one format to a second format that can be output from the transformation system. Such independent acts produce a concrete, tangible, and useful result – namely, the creation of XML items in one or more second formats that are output from the transformation system.

Additionally, the Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." ... Without question, *software code alone qualifies as an invention eligible for patenting under these categories*, at least as processes. *Id.* at 1338 (emphasis added).

The subject claim clearly pertains to software code comprising *a transformer that transforms one or more input XML items in a first format to one or more transformed XML items in one or more second formats and an output manager that facilitates at least one of selectively pulling and pushing a subset of the one or more input XML items* that facilitate the transformation and transmission of XML items. The XML items input to the system are software code, and the components within the transformation system are software code that effectuates a process for data transformation. It is submitted that all that is relevant is the fact that software code is received, processed, and output by a system, and such software produces a useful, concrete, and tangible result.

In view of at least the foregoing, it readily apparent that the subject claim sets forth a useful, concrete and tangible result. Accordingly, withdrawal of this rejection is requested.

III. Rejection of Claims 1-19 Under 35 U.S.C §112

Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection should be withdrawn for at least the following reasons. In view of the amendments made herein to correct certain informalities, it is believed that this rejection is moot. Therefore, it is respectfully requested that this rejection be withdrawn.

IV. Rejection of Claims 1-19 Under 35 U.S.C. §103(a)

Claims 1-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over ADO.NET (English Translation) and further in view of Omoigui (U.S. 2003/0126136 A1). This rejection should be withdrawn for at least the following reasons. ADO.NET and Omoigui, either alone or in combination, do not teach or suggest each and every aspect set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The claimed invention discloses a system and method for providing a streaming input and streaming output incremental XML transformer that can be employed in push and/or pull model processing. The XML transformer provides for incrementally building output from XML data by loading a subset of an XML document into memory to perform a selective transformation. More particularly, independent claims 1 and 19 recite similar limitations, namely *a transformer that transforms one or more input XML items in a first format to one or more transformed XML items in one or more second formats, the one or more input XML items comprise a subset of XML items contained in a XML document.* ADO.NET and Omoigui are silent with regard to such novel aspects.

ADO.NET generally relates to XML data and discloses an XMLReader and a component that provides XML, XSL, XSL/T, and X-Path tools presumably utilized by the XMLReader to produce an XMLDataDocument. Insofar as it can be determined from the disclosure in the reference, the ADO.NET system receives XML documents as input to facilitate the composition of a XMLDataDocument object containing the individual XML documents. In the subject Office Action, it is incorrectly contended that the reference discloses transforming input XML items in one format to transformed XML items in a second format, since the reference provides a data set object, and that the transformed XML item may not actually be an XML item (See Office Action dated July 18, 2006). However, the instant specification clearly discloses that the result of the transformation steps is *transformed XML items* and not some other type of data (See e.g., page 10, lines 19-23). Accordingly, the reference's disclosure of a data set object is not equivalent to

transforming ***one or more input XML items in a first format to one or more transformed XML items in one or more second formats.***

In addition, it is noted that in previous correspondence, it was stated that ADO.NET did not provide a comprehensible description of its activities sufficient to enable one of ordinary skill in the art to effectuate the disclosure therein without undue experimentation to produce the claimed invention. More specifically, the level of detail set forth in the disclosure is clearly insufficient, as the methods of operation are not clearly articulated anywhere in the reference. For example, the illustration that presumably represents a schematic of the entire system does not clearly explain the arrows connecting individual components, thus leaving the true functionality open to interpretation and conjecture (See page 5). Moreover, many sections within the reference provide only a listing of terms without definitions or explanations that would enable one to understand the system's functionality (See page 9). Thus applicants' representative maintains that despite the proffered English translation of ADO.NET the cited document does not provide an enabling reference for the purported teachings asserted by the Examiner.

Furthermore, the Examiner concedes that ADO.NET does not teach or suggest ***an output managing component that facilitates at least one of selectively pulling and pushing a subset of the transformed XML items prior to transforming all input XML items*** and contends that Omoigui compensates for such deficiencies.

Omoigui generally relates to an information retrieval and presentation framework for transferring information between client and server systems. In the subject Office Action, the Examiner incorrectly contends that obtaining and merging XML files, as disclosed in the reference, is equivalent to ***selectively pulling and pushing a subset of the transformed XML items prior to transforming all input XML items*** (See Office Action dated July 18, 2006). In the section of the reference cited by the Examiner, it is disclosed that the Results Browser component receives one or more XML files from a Query Manager component and subsequently merges said XML files into a single XML document (See paragraph 0759). The reference does not, however, disclose that there is a specified procedure by which the XML files are merged. The system of Omoigui simply retrieves the desired XML files and merges the data within said XML files into a new XML file. In fact, the reference does not mention anywhere that ***a subset of the transformed XML items*** can be pushed or retrieved **before transforming all input XML items**. Contrarily, the present invention discloses that, rather than retrieving and transforming

one hundred percent of the XML items before outputting the transformed XML items, some **transformed XML items** are available **prior to transforming all input XML items**. Thus it is readily apparent that ADO.NET and Omoigui, either alone or in combination, are silent with regard to *an output managing component that facilitates at least one of selectively pulling and pushing a subset of the transformed XML items prior to transforming all input XML items*.

In view of the foregoing, it is believed that neither ADO.NET nor Omoigui, alone or in combination, teaches or suggests each and every aspect of independent claims 1 and 19 (and claims 2-18 that depend there from). Therefore, it is respectfully requested that this rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP296US]. Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,
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